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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stephan Brunner

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CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN, TX 78758

EXAMINER

DUNHAM, JASON B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/945,450	Applicant(s) BRUNNER ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 95-102, 104 and 113-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 95-102, 104 and 113-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/10/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amended claims 95 and 98 and canceled claim 103 in the response filed November 6, 2008 in reply to the office action dated August 13, 2008. Claims 95-102, 104, and 113-121 are pending. Applicant's amendments to claim 95 rendered the previous 35 USC 112, 2nd paragraph rejection for indefiniteness moot.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Referring to claims 95-104 and 113-121. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and

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Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Independent claim 95 fails to recite "logic blocks" (i.e. computer programs) that are not explicitly embodied on a tangible computer-readable medium; applicant's specification paragraph 22 recites mediums embodied as non-statutory carrier waves and signals. See MPEP 2106.01 discussing computer related non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 95 – 102, 104, and 113 - 121 are rejected under 35 U.S.C. 103(a) as being obvious over Henson (US 6,167,383) in view of Klencke (US 5,867,709) and further in view of Hinshaw (US 6,571,192).

Referring to claim 95. Henson discloses an apparatus configured to customize a product and comprising a computer-readable storage medium encoding logic blocks of a program code configured to be executed by a processor, the logic blocks comprising:

- a logic block to create a customizable product, the customizable product including a set of one or more attributes to define the customizable product (Henson: abstract and figure 3a disclosing options or attributes);

Henson discloses the above but does not explicitly disclose logic blocks to assign customizable products to classes and component products to subclasses. Klencke discloses:

- a logic block to assign the customizable product to a customizable product class, wherein the customizable product class is a parent class of a hierarchy defining a configurator, and the configurator is configured to reference the hierarchy to permit a user to configure a customizable product for purchase (Klencke: abstract);

- a logic block to add a component product class to the customizable product class, wherein the component product class is a subclass of the customizable product class, and the component product class comprises one or more component products selectable for adding to the customizable product (Klencke: column 4, lines 55 – column 5, line 2);

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the apparatus of Henson to have included logic blocks (i.e. components programmed to assist in customizing a product) to assign the customizable product to a customizable product class and to add a component product

class to the customizable product class, as taught by Klencke, in order to follow a parent-child relationship while configuring the product (Klencke: abstract).

The combination of Henson and Klencke further discloses:

a logic block to add a customizable class rule to the customizable product class prohibiting the selection of one or more component products for addition to the customizable product after selection of a specific component product for addition (Henson: figure 3a and column 7, line 39 - column 8, line 33 disclosing validation of additional components).

a logic block to map a customizable user interface to the customizable product class, the customizable user interface to provide access structure to the configurator (Henson: figure 3a showing a GUI allowing a user to configure their customizable product).

The combination of Henson and Klencke discloses all of the above but does not expressly disclose a logic block to provide natural language templates containing fill in the blank sentences and generating the customizable class rule. Hinshaw discloses an apparatus configured to customize a product comprising logic to provide a natural language template with a fill in the blank sentence containing a mathematical expression (Hinshaw: abstract, column 2, lines 42-48, and figures 12-14 disclosing software for allowing a user to enter positive or negative answers in order to configure a bedding system of a particular box spring and mattress). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the apparatus of Henson and Klencke to have included a logic block to provide natural

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language templates containing fill in the blank sentences and generating the customizable class rule, as taught by Hinshaw, in order to obtain a recommended product for a user (Hinshaw: abstract).

Referring to claims 96-97. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the component product class includes component product subclasses (Klencke: column 4, lines 55 – column 5, line 2) and inherits the attributes of the customizable product class (Klencke: abstract).

Referring to claim 98. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus comprising a logic block to add one or more component product classes to a port (Klencke: figure 3 & column 5, lines 64 – column 6, lines 24); and a logic block to add the port to the customizable product class, the port to allow the configurator to classify a group of component products (Klencke: figure 3 & column 5, lines 64 – column 6, lines 24). The examiner notes that applicant defines a port as a component product and Klencke discloses classes containing product customizations.

Referring to claims 99-101. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus including a default, minimum, and maximum cardinality to constrain the number of component products, associated with the port, selectable by the configurator (Henson: figure 5 showing a memory section with a default of 96 MB SDRAM, minimum of 64 MB, and maximum of 384 MB).

Referring to claim 102. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the class rules include a collection of expressions including a property path, constant, and an operator (Henson: figure 4

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disclosing guidance to the customer regarding selection of a video card). The examiner notes applicant's specification paragraphs 61 disclosing the use of customizable class rules to guide a customer through product choice.

Referring to claim 104. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the class rule is a subclass of the customizable product class (Klencke: column 4, lines 55 – column 5, line 2).

Referring to claim 113. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the component product class includes a static attribute not associated with a parent class (Henson: figure 5 disclosing the static attribute of a 400 MHz Pentium II processor). The examiner notes applicant's specification paragraph 47 disclosing defined attributes of memory and type of cabinet based on the type of PC).

Referring to claim 114. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the component product class, customizable class rules, and customizable user interface are object-oriented classes (Klencke: abstract).

Referring to claim 115. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the customizable product comprises an object-oriented structure (Klencke: abstract).

Referring to claim 116. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the customizable product includes versioning (Klencke: column 3, lines 3-36).

Referring to claim 117. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the configurator is stored in a data store (Henson: abstract disclosing a database for storing configuration options).

Referring to claim 118. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the customizable user interface is configured to allow customization of a presentation of component products (Henson: figure 5 allowing a user to choose their view).

Referring to claims 119-120. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus for customizing a product wherein the customizable user interface is configured to be customized for a particular product line (Henson: figure 5 showing the UI for the Dimension XPS R line) or customer base (Henson: abstract).

Referring to claim 121. The combination of Henson, Klencke, and Hinshaw further discloses an apparatus wherein the customizable user interface is configured to allow a runtime session to dynamically generate a user interface from a customer class (Klencke: column 4, lines 55 – column 5, line 2).

Response to Arguments

Applicant's arguments filed November 6, 2008 regarding the 35 USC 101 rejection have been fully considered but they are not persuasive. The rejection is maintained as applicant's specification discloses mediums as non-statutory carrier waves and signals.

Applicant's arguments with respect to the 35 USC 103(a) rejection of the above claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

JBD
1/28/09